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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/274,979	03/23/1999	PHILLIP MERRICK	A007145	9188

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EXAMINER
COURTENAY III, ST JOHN

ART UNIT	PAPER NUMBER
2151	

DATE MAILED: 04/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

Office Action Summary	Application No. 09/274,979	Applicant(s) Merrick et al.
	Examiner St. John Courtenay III	Art Unit 2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ___3___ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Mar 23, 1999* _____ .

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1, 3, 8, 10, 22, 23, 28, 29, 49, 50, 55, 56, 64, 65, 70-75, 90-10̸1̸* and 110-117 is/are pending in the application.

    4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☒ Claim(s) *70-75, 90-101, and 110-113* _____ is/are allowed.

6) ☒ Claim(s) *1, 3, 8, 10, 22, 23, 28, 29, 49, 50, 55, 56, 64, and 65* _____ is/are rejected.

7) ☒ Claim(s) *114-117* _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

    a) ☐ All b) ☐ Some* c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    *See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

ST. JOHN COURTENAY III
PRIMARY EXAMINER

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). *5*

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other: _____

U. S. Patent and Trademark Office
PTO-326 (Rev. 9-00)   Office Action Summary   Part of Paper No. 8

Detailed Action

Objection to the claims:
As per claims 114–117:
These claims could not be examined as page 80 of the instant specification is missing from the file wrapper. Either page 80 was missing as filed or was lost within the PTO. Claims 114–117 stand objected to as missing from the instant application. A replacement sheet 80, as originally filed, is requested in response to this office action.

Claim Rejections - 35 U.S.C. 102
The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:
A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 3, 8, 10, 22, 28, 29, 49, 50, 55, 56, 64 & 65 are rejected under 35 U.S.C. § 102(a) as being anticipated by Merrick et al., "Web Interface Definition Language (WIDL)", NOTE-widl-970922, http://www.w3.org/TR/NOTE-widl-970922, Submitted to W3C 22 September 1997, pages 1-16.

Note: The above Merrick et al. WIDL reference discloses two authors: Phillip Merrick and Charles Allen. The instant invention was filed by Phillip Merrick and two co-inventors: Stewart Allen and Joseph Lapp. The cited reference therefore constitutes a different inventive entity than the present application. Therefore, the reliance upon Merrick et al. as prior art is proper. M.P.E.P. 715.01 (a).

As per independent claim 1:
Merrick teaches a method of communicating between first and second machines, the method comprising the steps of: generating a message at a first machine [e.g., see *"WIDL is an application of the eXtensible Markup Language (XML); it allows interactions with Web servers to be defined as functional interfaces that can be accessed by remote systems over standard Web protocols"* discussion, abstract, page 1] including at least one

argument and a type label for the argument; and transmitting the message from the first machine [see code listing page 6, NAME and TYPE].

As per independent claim 3:
Merrick teaches a method of invoking a service at a first machine, the method comprising the steps of: receiving at the first machine a service invocation request generated at a second machine, the service invocation request: [e.g., see *"WIDL is an application of the eXtensible Markup Language (XML); it allows interactions with Web servers to be defined as functional interfaces that can be accessed by remote systems over standard Web protocols"* discussion, abstract, page 1] including at least one argument and a type label for the argument; and invoking the service in response to the request [see code listing page 6, NAME and TYPE].

As per independent claim 8:
Merrick teaches a method of communicating between first and second machines, the method comprising the steps of: generating a message at the second machine, the message including at least one argument containing at least one data item, [e.g., see *"WIDL is an application of the eXtensible Markup Language (XML); it allows interactions with Web servers to be defined as functional interfaces that can be accessed by remote systems over standard Web protocols"* discussion, abstract, page 1]the message further including a semantic label for the data item; and transmitting the message from the second machine [see code listing page 6, NAME and TYPE].

As per independent claim 10
Merrick teaches a method of invoking a service at a first machine, the method comprising the steps of: receiving at the first machine a service invocation request generated at a second machine, [e.g., see *"WIDL is an application of the eXtensible Markup Language (XML); it allows interactions with Web servers to be defined as functional interfaces that can be accessed by remote systems over standard Web protocols"* discussion, abstract, page 1] the request including at least one argument containing at least one data item, the service invocation request further including a semantic label for the data item; and invoking the service in response to the request [see code listing page 6, NAME and TYPE].

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As per independent claim 22:

Merrick teaches a method of invoking a service at a first machine, the method comprising the steps of: receiving at the first machine a service invocation request ; invoking the service in response to the request [e.g., see *"WIDL is an application of the eXtensible Markup Language (XML); it allows interactions with Web servers to be defined as functional interfaces that can be accessed by remote systems over standard Web protocols"* discussion, abstract, page 1]; and transmitting from the first machine a service invocation reply including at least one output argument and a type label for the argument [see code listing page 6, NAME and TYPE].

As per independent claim 23:

Merrick teaches a method of invoking a service at a first machine, the method comprising the steps of: transmitting a service invocation request from a second machine; and [e.g., see *"WIDL is an application of the eXtensible Markup Language (XML); it allows interactions with Web servers to be defined as functional interfaces that can be accessed by remote systems over standard Web protocols"* discussion, abstract, page 1] receiving at the second machine a service invocation reply including at least one output argument and a type label for the argument [see code listing page 6, NAME and TYPE].

As per independent claim 28:

Merrick teaches a method of invoking a service at a first machine, the method comprising the steps of: receiving at the first machine a service invocation request [e.g., see *"WIDL is an application of the eXtensible Markup Language (XML); it allows interactions with Web servers to be defined as functional interfaces that can be accessed by remote systems over standard Web protocols"* discussion, abstract, page 1]; invoking the service in response to the request; and transmitting from the first machine a service invocation reply including at least one output argument containing at least one data item, the service invocation reply further including a semantic label for the data item [see code listing page 6, NAME and TYPE].

As per independent claim 29:

Merrick teaches a method of invoking a service at a first machine, the method comprising the steps of: transmitting a service invocation request from a second machine; and receiving at the second machine a service invocation reply including at least one output argument containing at least one data item, [e.g., see *"WIDL is an application of the eXtensible Markup Language (XML); it allows interactions with Web servers to be defined as functional interfaces that can be accessed by remote systems over standard Web protocols"* discussion, abstract, page 1] the service invocation reply further including a semantic label for the data item [see code listing page 6, NAME and TYPE].

As per independent claim 49:

Merrick teaches a method of invoking a service at a first machine, the method comprising the steps of: generating at a second machine a service invocation request expressed in a markup language [e.g., see *"WIDL is an application of the eXtensible Markup Language (XML); it allows interactions with Web servers to be defined as functional interfaces that can be accessed by remote systems over standard Web protocols"* discussion, abstract, page 1]; and transmitting the message from the second machine [see code listing page 6, NAME and TYPE; see §5 "WIDL Reference" discussion of XML beginning on page 9 e.g., – *"The Web Interface Definition Language (WIDL) is an application of the eXtensible Markup Language (XML); its definition consists of the various XML elements defined in this section."*].

As per independent claim 50:

Merrick teaches a method of invoking a service at a first machine, the method comprising the steps of: receiving at the first machine a service invocation request generated at a second machine [e.g., see *"WIDL is an application of the eXtensible Markup Language (XML); it allows interactions with Web servers to be defined as functional interfaces that can be accessed by remote systems over standard Web protocols"* discussion, abstract, page 1], the service invocation request expressed in a markup language; and invoking the service in response to the request [see code listing page 6, NAME and TYPE; see §5 "WIDL Reference" discussion of XML beginning on page 9 e.g., – *"The Web Interface Definition Language (WIDL) is an application of the eXtensible Markup Language (XML); its definition consists of the various XML elements defined in this section."*].

As per independent claim 55:

Merrick teaches a method of invoking a service at a first machine, the method comprising the steps of: receiving at the first machine a service invocation request [e.g., see *"WIDL is an application of the eXtensible Markup Language (XML); it allows interactions with Web servers to be defined as functional interfaces that can be accessed by remote systems over standard Web protocols"* discussion, abstract, page 1]; invoking the service in response to the request; and transmitting from the first machine a service invocation reply expressed in a markup language [see code listing page 6, NAME and TYPE; see §5 "WIDL Reference" discussion of XML beginning on page 9 e.g., – *"The Web Interface Definition Language (WIDL) is an application of the eXtensible Markup Language (XML); its definition consists of the various XML elements defined in this section."*].

As per independent claim 56:

Merrick teaches a method of invoking a service at a first machine, the method comprising the steps of transmitting a service invocation request from a second machine [e.g., see *"WIDL is an application of the eXtensible Markup Language (XML); it allows interactions with Web servers to be defined as functional interfaces that can be accessed by remote systems over standard Web protocols"* discussion, abstract, page 1]; and receiving at the second machine a service invocation reply expressed in a markup language [see code listing page 6, NAME and TYPE; see §5 "WIDL Reference" discussion of XML beginning on page 9 e.g., – *"The Web Interface Definition Language (WIDL) is an application of the eXtensible Markup Language (XML); its definition consists of the various XML elements defined in this section."*].

As per independent claim 64:

Merrick teaches a method of invoking a service at a first machine from a second machine, comprising the steps of generating a service invocation request at the second machine in compliance with a markup language-based message encoding [e.g., see *"WIDL is an application of the eXtensible Markup Language (XML); it allows*

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interactions with Web servers to be defined as functional interfaces that can be accessed by remote systems over standard Web protocols" discussion, abstract, page 1], and transmitting the service invocation request from the second machine [see §5 "WIDL Reference" discussion of XML beginning on page 9 e.g., – *"The Web Interface Definition Language (WIDL) is an application of the eXtensible Markup Language (XML); its definition consists of the various XML elements defined in this section. "*], the message including plural elements and wherein all elements in the message have element type names selected from an encoding group consisting of no more than six element type names [Merrick teaches the use of THREE MAJOR elements and THREE Minor elements, page 9].

As per independent claim 65:
Merrick teaches a method of invoking a service at a first machine, comprising the steps of: receiving at the first machine a service invocation request generated at a second machine in compliance with a markup language-based message encoding[e.g., see *"WIDL is an application of the eXtensible Markup Language (XML); it allows interactions with Web servers to be defined as functional interfaces that can be accessed by remote systems over standard Web protocols"* discussion, abstract, page 1], the message including plural elements and wherein all elements in the message have element type names selected from an encoding group consisting of no more than six element type names [Merrick teaches the use of THREE MAJOR elements and THREE Minor elements, page 9]; and invoking the service in response to the request [see §5 "WIDL Reference" discussion of XML beginning on page 9 e.g., – *"The Web Interface Definition Language (WIDL) is an application of the eXtensible Markup Language (XML); its definition consists of the various XML elements defined in this section. "*].

Prior Art not relied upon:
Please refer to the references listed on the attached PTO-892 which are not relied upon in the claim rejections detailed above.

Objective — Reducing and Simplifying the areas of disagreement:
• The Examiner solicits Applicant's cooperation in *reducing and simplifying the areas of disagreement* by doing the following: 1) amending the independent claims in a manner fully supported by the specification to *clearly distinguish* over the prior art of record, AND/OR 2) directing *clear* and *concise* arguments to the *specific claim language and claim elements* that Applicant believes are not fairly taught nor suggested by the cited prior art of record. Applicant should cancel claims where appropriate. Applicant should preferably avoid arguing general differences between the cited references and the instant invention as disclosed in the specification. Your cooperation is appreciated.

• **M.P.E.P. 2001.06(b) Information Relating to or from Copending United States Patent Applications**
The individuals covered by 37 CFR 1.56 have a duty to bring to the attention of the examiner, or other Office official involved with the examination of a particular application, information within their knowledge as to other copending United States applications which are "material to patentability" of the application in Question, as set forth by the Court in *Armour & Co.* v. *Swift & Co.*, 175 USPQ 70, 79 (7th Cir. 1972).

Format of Amended Claims pursuant to 37 C.F.R. 1.121:

37 CFR § 1.121 amendments were optional on November 7, 2000 and became mandatory on March 1, 2001.

• **Please help expedite the prosecution of this application by including a clean set of all pending claims, consolidating all previous versions of pending claims from a series of separate amendments into <u>a single clean version in a single amendment paper</u>. This submission of a clean version of all of the pending claims will be construed as directing the cancellation of all previous versions of any pending claims. No marked-up version will be required to accompany the clean version where no changes other than the consolidation are being made. 37 CFR § 1.121.**

For details of the PBG final rules please refer to the following PTO website:
http://www.uspto.gov/web/offices/dcom/olia/pbg/index.html

Please help prevent common after-allowance problems that delay publication:

- Prevent after-allowance IDS problems: If the Examiner has not considered and provided initialed copies of ALL submitted IDS PTO-1449 papers in the first action, please bring this omission to the attention of the Examiner in the next response. In many cases, recent delays with the U.S. Postal system have caused problems receiving and matching IDS statements with the file wrapper, particularly when IDS material is voluminous and submitted in one or more boxes. Only non-patent literature and foreign patents need be submitted as paper copies. The Examiner has ready access to U.S. patents in electronic and paper form – please do not send paper copies of U.S. Patents listed on your PTO-1449. The optional submission of IDS material in CD-R format is encouraged and appreciated by the Examiner of record, but is not required by current rules.

- Prevent problems where the "Brief Description of the Drawings" section of the application does not EXACTLY match the actual figures submitted. Please verify that your "Brief Description of the Drawings" section agrees EXACTLY with the figure numbers of your drawings, otherwise the application will be returned to the Examiner by the printer for correction. This will delay your publication date, should this application go to issue.

Please verify the CORRECT SERIAL NUMBER in all responses:
• All incoming papers received by the PTO are matched with the application file by application serial number. Failure to include a correct application serial number on PTO correspondence will result in significant processing delays. The use of the correct PTO application serial number is required on all future correspondence.

Please verify your CORRECT MAILING ADDRESS:
• If your mailing address changes after the filing of the instant application you must promptly notify the PTO of your CHANGE OF ADDRESS to prevent PTO correspondence being returned by the Post Office as undeliverable. It is preferable to submit your CHANGE OF ADDRESS and/or POWER of ATTORNEY papers separately from all other submitted responses to ensure entry by docketing personnel and avoid confusion with other papers.

How to Contact the Examiner:

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to **St. John Courtenay III** whose voice telephone number is **(703) 308-5217.** A voice mail service is also available at this number.

- **All responses sent by U.S. Mail should be mailed to:**
  Commissioner of Patents and Trademarks
  Washington, D.C. 20231

- **Hand-delivered responses should be brought to Crystal Park Two, 2021 Crystal Drive, Arlington. VA., Fourth Floor (Receptionist).** All hand-delivered responses will be handled and entered by the docketing personnel. Please do not hand deliver responses directly to the Examiner.

IMPORTANT CHANGE IN PTO FAX POLICY:

- **AFTER-FINAL faxes must be signed and sent to: (703) 746-7238.**
- **OFFICIAL faxes must be signed and sent to: (703) 746-7239.**
- **NON OFFICIAL faxes should not be signed, please send to: (703) 746-7240, or to Examiner Courtenay's desktop computer at 703-746-5472.**

All OFFICIAL faxes will be handled and entered by the docketing personnel. The date of entry will correspond to the actual FAX reception date unless that date is a Saturday, Sunday, or a Federal Holiday within the District of Columbia, in which case the official date of receipt will be the next business day. The application file will be promptly forwarded to the Examiner unless the application file must be sent to another area of the Office, e.g., Finance Division for fee charging, etc.

To avoid ongoing Washington D.C. area mail processing delays, the Examiner requests that Applicant direct all communications to the PTO by fax. All incoming faxes are securely stored on PTO computers that are dedicated to fax reception. If you send a fax, please do not send duplicate papers via U.S. mail.

- Any inquiry of a general nature or relating to the status of this application should be directed to the **TC 2100 Group receptionist: (703) 305-3900.**

Please direct inquiries regarding fees, paper matching, and other issues not involving the Examiner to: Technical Center 2100 CUSTOMER SERVICE: 703 306-5631

Normal Flex work schedule: Sun. 1/2 day, Sat. 1/2 day, Monday, Tuesday off, Wed., Thurs., Friday.

ST. JOHN COURTENAY III
PRIMARY EXAMINER

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